

**REMARKS****I. Status of the Claims**

Claims 18-51 are pending in this application. Claim 29 has been cancelled and independent claims 18, 47, 49, and 50 have been amended to include the limitations recited in claim 29. Additionally claims 25-28, 30, 31, 35-40, 42-46, and 48 have been amended to correct minor errors in the claims. Support for these amendments can be found in the claims as originally filed. These amendments raise no issue of new matter and Applicants respectfully request their entry.

**II. Rejections Under 35 U.S.C. § 102****A. Tian et al.**

Claims 18, 32-35, 40-45, 47, and 49-51 have been rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Tian et al. (WO 99/13844) ("Tian"). Office Action at page 2. Applicants respectfully submit that this rejection has been rendered moot by the foregoing amendments incorporating the subject matter of claim 29, which was not rejected by the Examiner, into the independent claims.

Accordingly, the rejection under § 102(a) has been overcome and should be withdrawn.

**B. Asmus et al.**

Claims 18, 32-35, 40, 42-45, 47, and 50 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Asmus et al. (WO 97/00668) ("Asmus"). Office Action at page 2. Applicants respectfully traverse this rejection for the same reason as above, since claim 29 was also not rejected. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

### III. Rejections Under 35 U.S.C. § 103

#### A. Mitsumatsu et al.

Claims 18, 26-44, and 46-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu") for the reasons disclosed on pages 3-4 of the Office Action. Applicants respectfully traverse this rejection for the reasons set forth below.

To establish a prima facie case of obviousness the Examiner has the burden to show, among other requirements, that the prior art reference or references teach or suggest all the claim limitations. M.P.E.P. § 2143. The Examiner has not shown that Mitsumatsu teaches "at least one of an opacifier and a pearlescent agent." The Examiner, on page 3 of the Office Action, states only that Mitsumatsu teaches an optical brightener, but an optical brightener is not synonymous with an opacifier or pearlescent agent. Specifically, optical brighteners, as defined in Mitsumatsu, "are compounds which absorb ultraviolet light and re-emit the energy in the form of visible light." In contrast, opacity, as defined in Merriam-Webster's Collegiate Dictionary, is "the quality or state of a body that makes it impervious to the rays of light." *Merriam Webster's Collegiate Dictionary* 811 (10<sup>th</sup> ed. 2001). The same reference defines pearlescent as "having a pearly luster." *Id.* at 853. Thus, it is clear that the term optical brightener is not synonymous with a pearlescent agent or opacifier. Thus, Applicants respectfully submit that Mitsumatsu does not establish a prima facie case of obviousness at least because all the claim limitations are not suggested. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

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**B. Mitsumatsu et al. in view of S bag et al.**

Claims 19-25, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu as applied to claims 18, 26-44, 46-51 as above, and further in view of Sebag et al. (WO 98/03155) ("Sebag") for the reasons disclosed on pages 4-5 of the Office Action. Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants respectfully submit that the Examiner has failed to satisfy her burden of proof for setting forth a prima facie case of obviousness. The Examiner has not made the requisite showing, as is set forth by M.P.E.P. § 2142, that (1) there is some suggestion or motivation to modify the reference or to combine the reference teachings, and (2) that there is reasonable expectation of success based on the prior art.

The Federal Circuit has established a high burden for the Examiner to set forth a prima facie case of obviousness. The Court has held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence in the record. The precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The Court further held that "[t]he examiner's conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question is material to patentability, and could not be resolved on subjective belief and unknown authority." *Id.* at 1343-44.

Here, the Examiner has not presented objective evidence to support her subjective, unsupported assertion of obviousness. In fact, without further explanation, the Examiner's rejection in the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo compositions

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comprising silicone emulsion in Mitsumatsu by substituting the triazole with distearyl ether as motivated by Sebag, because of the expectation of successfully producing shampoo compositions with similar pearlescent effect, good homogeneity with improved stability and foaming power.

Office Action at 5. As described above, the Federal Circuit has rejected Examiners' attempts to use such general, non-specific and perfunctory statements to establish a case of prima facie obviousness. See *Lee*, 277 F.3d at 1338.

The fact that both references are shampoo compositions which could have similar pearlescent effect, homogeneity, and foaming power is not enough to make a prima facie case of obviousness when considering the hundreds of shampoos which could have those properties. There is simply no evidence that one skilled in the art would have been motivated to choose the pearlescent agent of Sebag from the myriad of such existing agents.

Applicants respectfully assert there is also no reasonable expectation of success for the combination proposed by the Examiner. The Mitsumatsu disclosure points out the importance of triazole to the invention:

Shampoo compositions typically include an anionic deterative surfactant for good cleansing. These anionic deterative surfactants may interfere with the deposition of optical brighteners. Triazoles which have a slight positive charge have good compatibility with such anionic deterative surfactants in that their positive charges generate a weak bond to suspend itself, yet their positive charges are not too strong to make salts or complexes with the anionic surfactants. Further, triazoles are believed to have good deposition on the surface of the hair, as hair is slightly negatively charged. Thus, shampoo compositions comprising triazoles can provide good deposition to the hair in combination with a wide variety of deterative surfactants.

Mitsumatsu at page 4. Thus, one skilled in the art reading this disclosure would realize triazole to be an essential ingredient of the Mitsumatsu invention and would not reasonably expect to successfully substitute it with another pearlescent agent.

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For at least the above reasons, Applicants respectfully submit that Mitsumatsu in view of Sebag does not establish a prima facie case of obviousness. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

**IV. Double Patenting Rejection**

Claims 18-51 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,512,238. While Applicants do not agree with the Examiner, in order to advance prosecution of this application, Applicants have filed herewith a Terminal Disclaimer over U.S. Patent No. 6,512,238. Accordingly, Applicants respectfully submit that this ground for rejection should be withdrawn.

**V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes a telephone call could be useful in resolving any outstanding issues, she is invited to contact Applicants' undersigned counsel at 202-408-4162.


Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 06-0916.

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Respectfully submitted,

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